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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/571,731	03/14/2006	Yoshiyuki Imanishi	268A 3838 PCT	2776

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EXAMINER

CHAWLA, JYOTI

ART UNIT	PAPER NUMBER
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1794

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/571,731	Applicant(s) IMANISHI ET AL.	
	Examiner JYOTI CHAWLA	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>6/19/2006</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claims 1-7 are pending and examined in the application.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1-3, the use of parenthesis and phrase "and the like" renders the claims indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "and the like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Claim 4, as recited is indefinite for the recitation of "wherein Worcestershire sauces or flavorings which mainly consists of one or at least two of sugars, amino acids, hydrolyzed proteins, extracts of vegetables, extracts of meats, yeast extracts and spices are used for the seasoning liquid", as recited it is unclear as to which sauces and /or seasoning elements are actually required by the claim as recited.

Further claim 4 includes a broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a

Art Unit: 1794

required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 4 recites the broad recitation of "consists of one or at least two of ..." which has broad limitation of "one" and narrower statement of the range/limitation "or at least two of..". Thus the claim as recited is unclear whether one or at least two of the ingredients listed in lines 3-4 of claim are required. Correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Art Unit: 1794

(A) Claims 1 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomoda (US 4988528) in view of Kozuki (JP 2002-119234) {English Abstract only}.

Regarding claim 1, Tomoda teaches a process of producing ready-to-eat fried noodle comprising the steps of molding seasoned lines of noodle into a predetermined shape to form a mass of noodles and oil frying the mass of noodles to produce a seasoned and oil fried mass of noodles (Column 2, lines 19-52 and column 3, lines 25-42, Column 4, lines 3-6, Column 5, lines 15-34, Column 5, line 62 to Column 6, line 21). Tomoda is silent about baking the surface of this seasoned and oil fried mass of noodles to brown the noodles, however, baking foods to brown the surface of foods, including fried foods was known in the art at the time of the invention. Kozuki (abstract) teaches of instant noodles that are obtained by baking the fried noodles to provide some brown color. Thus, baking instant or ready-to-eat noodles after frying to impart baked flavor and added color was known in the art at the time of the invention. Therefore, it would have been a matter of routine determination for one of ordinary skill in the art at the time of the invention to modify Tomoda and include a baking step after frying step at least in order to add crispiness or crunch while also adding some appetizing color to fried ready-to-eat noodles.

(B) Claims 2-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tomoda (US 4988528) in view of Kozuki (JP 2002-119234, IDS reference) {English Abstract only}, further in view of Greene et al (US 6042866), hereinafter Greene.

Tomoda in view of Kozuki, has been applied to claim 1 as discussed above.

Regarding claim 2, Tomoda teaches a process of producing ready-to-eat fried noodles, however, Tomoda teaches extending and rolling noodle material to a predetermined thickness to form a noodle blank (Column 2, lines 19-52 and column 3, lines 25-42, Column 4, lines 3-6, Column 5, lines 15-34, Column 5, line 62 to Column 6, line 21); cutting the noodle blank to a predetermined width and waving it to form lines of noodle

Art Unit: 1794

(Column 5, lines 62, item 28). Tomoda teaches of steam treating noodles in a steam chamber or steamer (Column 5, lines 62-63, item 11), to gelatinize the noodles (alpha conversion) as instantly claimed. Tomoda also teaches spraying seasoning liquid of a predetermined concentration on the noodles (Column 6, lines 3-4), and molding the noodles to a predetermined shape and oil frying the noodles (Column 6, lines 5-23), as instantly claimed.

Tomoda teaches of making noodles from the dough, but, the reference is silent about the recitation of steps of mixing flour, starch, table salt, water and the like to make a material and kneading the material. However, mixing conventional ingredients including flour, starch, salt, water etc., to make the dough for noodles and kneading the dough prior to rolling and cutting noodles was well known in the art at the time of the invention, as evidenced by Greene (Column 1, lines 11-25). Therefore, it would have been well within the purview of one of ordinary skill in the art at the time the invention was made to modify Tomoda and include the recitation of conventionally known dough ingredients and conventional step of kneading in order to describe the process in greater detail. Also it is noted that inclusion of details of common ingredients of noodle dough and kneading step would not contribute patentable difference to the claims as recited, absent any clear and convincing evidence and /or arguments to the contrary.

Further, attention is invited to *In re Levin*, 84 USPQ 232 and the cases cited therein, which are considered in point in fact situation of the instant case. At page 234, the Court stated as follows:

This court has taken the position that new recipes or formulas for cooking food which involve the addition or elimination of common ingredients, or for treating them in ways which differ from the former practice, do not amount to invention, merely because it is not disclosed that, in the constantly developing art of preparing food, no one else ever did the particular thing upon which the applicant asserts his right to a patent. In all such cases, there is nothing patentable unless the applicant by a proper showing further establishes a coaction or cooperative relationship between the selected ingredients, which produces a new, unexpected and useful function. In *re Benjamin D. White*, 17

Art Unit: 1794

C.C.P.A. (Patents) 956, 39 F.2d 974, 5 USPQ 267; In re Mason et al., 33 C.C.P.A. (Patents) 1144, 156 F.2d 189, 70 USPQ 221.

Claim 3 recites all the same limitations as recited in process of claim 2, therefore, claim 3 is rejected for being obvious over Tomoda, as evidenced by Greene for the same reasons of record as discussed regarding the rejection of claim 2.

Regarding Claim 4 Tomoda teaches of addition of seasoning during the process of producing the ready-to-eat chow mien or fried noodle (Column 6, lines 3-4). Tomoda does not specify the spices, however, condiments and flavorings, (sweet flavor of sugar or molasses, soy sauce, which comprises of amino acids and hydrolyzed proteins), dried vegetables, meats etc., are known to be added to season packaged fried noodles, at the time of the invention. Therefore, it would be well within the purview of one of ordinary skill in the art at the time of the invention to modify Tomoda and include any conventional and desirable spices, flavors or condiments in the fried noodle product as taught by Tomoda. One of ordinary skill would have been motivated to do so at least in order to enhance the organoleptic and nutritional properties of the fried noodle product.

Regarding claims 5-7, Tomoda in view of Kozuki teaches a fried noodle that is baked, as discussed above in the office action regarding claim 1. However, Tomoda and Kozuki are silent about the baking temperature, however, cooking/ baking temperatures in the range recited by the applicant, i.e., 150 °C to 240 °C were known in the art to roast or bake a dry product so as to brown the surface of the product. Further, it was also known at the time of the invention to that time and temperature in a given range, for a given product are inversely related, i.e., the higher the temperature of baking the noodles, the lesser time the noodles need to be baked in order to get crisp and also develop the color. Therefore, it would have been a matter of routine determination by optimization

Art Unit: 1794

experimentation for one of ordinary skill at the time of the invention to determine desirable crispness and color of the noodles and also the time and temperature optimal for achieving the desired crisp texture and brown color. One would have been motivated to modify Tomoda at least in order to add desirable level of crunchy texture to the noodle product.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 3 and 6 of the current application 10/571,731 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2 of copending Application No. 10/571,732. Although the conflicting claims are not identical, they are not patentably distinct from each other because both applications claim process of making fried noodle with similar process steps.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTI CHAWLA whose telephone number is (571)272-8212. The examiner can normally be reached on 9:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks can be reached on (571) 272-1401. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JC
Examiner
Art Unit 1794

/KEITH D. HENDRICKS/
Supervisory Patent Examiner, Art Unit 1794